

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

OCT 25 2000

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIRO KAMIYAMA,
MASANORI KOSUGI, MASAHIRO KURATA,
SADAO SHIRAISHI and MICHIO KOBAYASHI

Appeal No. 1999-0761
Application 08/174,957

ORDER REMANDING TO EXAMINER

An examination of the file reveals that a new ground of rejection was raised in the Examiner's Answer mailed September 20, 1996 (Paper No. 17). Section 1208.01 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3, July 1997) states:

All answers citing new references or
containing new grounds of rejection or

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objection must be routed over the supervisory primary examiner's desk for review and signature.

The Examiner's Answer mailed September 20, 1996 (Paper No. 17) does not comply with the above requirement.

On November 7, 1996, appellants filed an amendment to claims 1 and 17. The Supplemental Examiner's Answer mailed August 18, 1998 (Paper No. 22) stated that "[a]ppellants have amended independent claims 1 and 17 to recite that the etching step is a single step process." With the entry of this amendment, the language of claims 1 and 17 in the Appendix to the Appeal Brief differs from its last amended version. 37 CFR § 1.192(c)(9)(1997) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for clarifying the record by explicitly stating either that the new ground of rejection has been withdrawn by the Examiner or that the new ground of rejection has been approved by the Supervisory Patent Examiner and for notification

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to appellants of such approval (The notification to appellants must include a copy of the approved Examiner's Answer.);

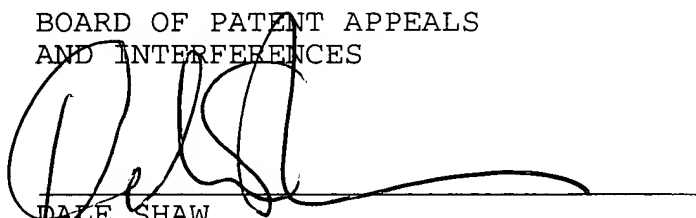
2. for notification to appellants to submit a corrected Appendix to replace the existing defective Appendix, or for the examiner to issue a supplemental Examiner's Answer to officially correct the Appendix; and

3. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

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